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First Named Inventor

Inui et al.

Art Unit

2112

Examiner Name

Kim T. Huynh

Attorney Docket Number

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ENCLOSURES (Check all that apply)

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Remarks

Appellants submit herewith an Amended Appeal Brief that clarifies the Real Party in Interest.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Winstead Sechrest & Mizek P.C.		
Signature			
Printed name	Robert A. Voigt, Jr.		
Date	08/15/2005	Reg. No.	47,159

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- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Inui et al.	:	Huynh, Kim T.
Serial No.: 10/065,060	:	Group Art Unit: 2112
Filed: September 13, 2002	:	
Title: COMPUTER DEVICE,	:	Lenovo, Inc.
EXPANSION DEVICE MANAGEMENT	:	Intellectual Property Law
METHOD, AND COMPUTER PROGRAM:	:	3039 Cornwallis Road
	:	Research Triangle Park, NC 27709

AMENDED APPEAL BRIEF

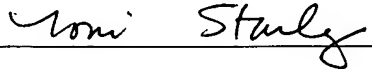
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I. **REAL PARTY IN INTEREST**

At the time of the filing of the above-identified application, International Business Machines Corporation was the assignee of the entire right, title and interest in the above-identified patent application. International Business Machines Corporation is currently undergoing negotiations with Lenovo (Singapore) Pte. Ltd. to transfer some of its intellectual property to them, including assigning the above-identified patent application to Lenovo (Singapore) Pte. Ltd.

CERTIFICATION UNDER 37 C.F.R. §1.8

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Signature

Toni Stanley

(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-15 are pending in the Application. Claims 1-15 stand rejected. Claims 1-15 are appealed.

IV. STATUS OF AMENDMENTS

The Appellants' response to the Office Action having a mailing date of February 2, 2005, has been considered, but the Examiner indicated that it did not place the application in condition for allowance because Appellants' arguments were deemed unpersuasive.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In one embodiment of the present invention, an apparatus comprises an interface which provides removable connection to a plurality of expansion devices. Specification, page 6, paragraph 0033; Figure 1, elements 23, 24, 25, 26, 30 and 35. The apparatus may further comprise an information storage unit for storing settings information which indicates whether the expansion devices connected to the interface are removable. Specification, page 7, paragraphs 0038 and 0040; Figure 1, element 43. The apparatus may further comprise a listing unit for listing the expansion devices removable from the interface, based on the settings information stored in the information storage unit. Specification, pages 7-8, paragraph 0043; Figure 1, elements 18, 23, 24, 25, 26, 30, 35 and 43; Figure 2, elements L and 18. The apparatus may further comprise the information storage unit and the listing unit together comprising an interface which allows expansion devices to be attached and

detached. Specification, pages 7-8, paragraph 0043; Figure 1, elements 18 and 43; Figure 2, elements L and 18.

In another embodiment of the present invention, an apparatus may comprise an interface section having a plurality of interfaces, each interface providing removable connection to a plurality of expansion devices. Specification, page 6, paragraph 0033; Figure 1, elements 23, 24, 25, 26, 30 and 35. The apparatus may further comprise a listing section for displaying a list based on settings information which indicates whether to permit removal of an expansion device from each of the interfaces. Specification, pages 7-8, paragraph 0043; Figure 1, elements 18, 23, 24, 25, 26, 30 and 35; Figure 2, element 18. The apparatus may further comprise a specification acceptance section for accepting specification of a specific interface from among the interfaces contained in said list. Specification, pages 7-8, paragraph 0043; Figure 1, elements 23, 25 and 30; Figure 2, element L. The apparatus may further comprise an unloading section for unloading a driver for the expansion device connected to the specific interface to allow the expansion device to be removed. Specification, pages 7-8, paragraph 0043. The apparatus may further comprise the listing section and specification acceptance section together comprising the plurality of interfaces which allow the expansion devices to be attached and detached. Specification, pages 7-8, paragraph 0043; Figure 1, elements 18, 24, 26 and 35; Figure 2, elements 18 and L.

In another embodiment of the present invention, a method may comprise the step of displaying an explicit list of removable expansion devices in response to a certain operation, based on an information list which indicates whether the expansion devices are removable from a computer device. Specification, pages 8-9, paragraphs 0047-0049; Figure 4, step S101; Figure 5. The method may further comprise accepting specification of a specific expansion device from among the expansion devices listed explicitly. Specification, page 9, paragraph 0050; Figure 4, step S102;

Figure 5. The method may further comprise unloading the specified specific expansion device from a system of the computer device. Specification, pages 7-8; paragraph 0043.

In another embodiment of the present invention, a program product may comprise a computer readable medium. Specification, page 5, paragraph 0030; Specification, pages 11-12, paragraphs 0064-0067; Figure 1, element 16. The program product may further comprise a computer executable program stored on the computer readable medium for execution on a computer device, the computer executable program being effective in executing the step of detecting expansion devices connected to the computer device. Specification, pages 5-7, paragraphs 0028-0042; Specification, page 9, paragraph 0053; Specification, pages 11-12, paragraphs 0064-0067; Figure 1, elements 10, 16; Figure 6. The computer executable program may further execute the step of accepting specification as to whether or not removal of the detected expansion devices from the computer device is prohibited. Specification, pages 5-7, paragraphs 0028-0042; Specification, pages 9-10, paragraphs 0054-0057; Specification, pages 11-12, paragraphs 0064-0067; Figure 1, elements 10, 16; Figure 7. The computer executable program may further execute the step of displaying a list of expansion devices, excluding the expansion devices which are prohibited from being removed, when requested to display a list of the expansion devices connected to the computer device. Specification, pages 5-7, paragraphs 0028-0042; Specification, pages 9-10, paragraphs 0054-0060; Specification, pages 11-12, paragraphs 0064-0067; Figure 1, elements 10, 16; Figure 2, element L; Figure 7.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-15 stand rejected under 35 U.S.C. §102(b) as being anticipated by Tachibana et al. (U.S. Patent No. 6,055,595) (hereinafter "Tachibana").

VII. ARGUMENT

The Examiner has rejected claims 1-15 under 35 U.S.C. §102(b) as being anticipated by Tachibana. Paper No. 5, page 2. Appellants respectfully traverse these rejections for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

A. Claim 1 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "an information storage unit for storing settings information which indicates whether the expansion devices connected to said interface are removable" as recited in claim 1. The Examiner cites element 32 in Figure 3 and column 2, lines 8-25 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 2. Appellants respectfully traverse and assert that Tachibana instead discloses an information apparatus which can automatically select and start/terminate an application program for executing the process corresponding to a PC card in response to insertion/removal of the PC card and a program starting control method. Column 2, lines 4-8. Tachibana further discloses means for registering card/program registration information indicating a correspondence relation between names of various cards and file names of various application programs used for effecting processes for the respective cards into the registry. Column 2, lines 12-16. Tachibana further discloses that means for acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. Column 2, lines 16-20. Tachibana further discloses means for requesting the OS to start the application program when the data of insertion/removal indicates the insertion. Column 2, lines 24-25. Hence,

Tachibana discloses automatically starting/terminating an application program in response to insertion/removal of a PC card. This is not the same as storing settings information which indicates whether the expansion devices connected to an interface are removable. Instead, Tachibana discloses storing the file names of application programs that are to be started or terminated in response to particular PC cards inserted or removed, respectively. Each PC card is associated with a file name of a particular application that is to be started when the PC card is inserted or is to be terminated when the PC card is removed. Thus, Tachibana does not disclose all of the limitations of claim 1, and thus Tachibana does not anticipate claim 1. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 2, lines 8-25) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 8. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 2, lines 8-25 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 2, lines 8-25 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 1. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "a listing unit for listing the expansion devices removable from said interface, based on said settings information stored in said information storage unit" as recited in claim 1. The Examiner cites element 32 in Figure 3 and column 2, lines 8-25 of Tachibana as

disclosing the above-cited claim limitation. Paper No. 5, page 2. Appellants respectfully traverse. As stated above, Tachibana instead discloses automatically starting/terminating an application program in response to insertion/removal of a PC card. There is no language in the cited passage that discloses a list of expansion devices that are removable from an interface. Neither is there any language in the cited passage that discloses listing the expansion devices that are removable from an interface based on settings information. Thus, Tachibana does not disclose all of the limitations of claim 1, and thus Tachibana does not anticipate claim 1. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner focuses on the language that Tachibana discloses a registry and a means for registering card/program registration information indicating a correspondence relation between names of various cards and file names of various application programs used for effecting processes for the respective cards into the registry. Column 2, lines 12-16. Paper No. 5, page 8. Hence, Tachibana discloses registering information that indicates a relation between the names of various cards and the file names of various application programs. The Examiner has not provided any basis in fact and/or technical reasoning to support the Examiner's interpretation of registering information that indicates a relation between the names of various cards and the file names of various application programs, as disclosed in Tachibana, as disclosing a listing unit for listing the expansion devices removable from an interface, based on the settings information stored in the information storage unit. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 2, lines 12-16 of Tachibana discloses a listing unit for listing the expansion devices removable from an interface, based on the settings information stored in the information storage unit, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence,

the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 1. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "said information storage unit and said listing unit together comprising an interface which allows expansion devices to be attached and detached" as recited in claim 1. The Examiner cites column 5, lines 47-56 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 2. Appellant respectfully traverses and asserts that Tachibana instead discloses that the operating system registers information relating to the inserted PC card into a registry. Hence, Tachibana discloses storing information that indicates that a particular PC card has been inserted into a particular PC card slot. There is no language in the cited passage that discloses an information storage unit (stores setting information) and a listing unit (lists expansion devices removable) together comprising an interface where the interface allows expansion devices to be attached and detached. Thus, Tachibana does not disclose all of the limitations of claim 1, and thus Tachibana does not anticipate claim 1. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 5, lines 47-56) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 8. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 5, lines 47-56 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 5, lines 47-56 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since

the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 1. M.P.E.P. §2131.

B. Claim 4 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "a listing section for displaying a list based on settings information which indicates whether to permit removal of an expansion device from each of said interface" as recited in claim 4. The Examiner cites column 6, lines 22-37 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 3. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information and then requests the operating system to start the application program. Requesting an operating system to start a specified application program upon the insertion of a PC card is not the same as displaying a list based on settings information. Neither is there any language in the cited passage that discloses displaying a list based on settings information which indicates whether to permit removal of an expansion device from an interface. Thus, Tachibana does not disclose all of the limitations of claim 4, and thus Tachibana does not anticipate claim 4. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 6, lines 22-37) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 9. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 6, lines 22-37 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must

make clear that column 6, lines 22-37 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 4. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "a specification acceptance section for accepting specification of a specific interface from among said interfaces contained in said list" as recited in claim 4. The Examiner cites column 6, lines 11-21 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that requests the operating system to issue device information held in the registry and acquires information indicating data of insertion/removal and information such as the identification of the PC card which is inserted or removed. There is no language in the cited passage that discloses a list which indicates whether to permit removal of an expansion device from each interface. Neither is there any language in the cited passage that discloses accepting specification of a specific interface from among the interfaces contained in such a list. Thus, Tachibana does not disclose all of the limitations of claim 4, and thus Tachibana does not anticipate claim 4. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 6, lines 11-21) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 9. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 6, lines 11-21 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat.

App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 6, lines 11-21 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 4. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "an unloading section for unloading a driver for the expansion device connected to said specific interface to allow the expansion device to be removed" as recited in claim 4. The Examiner cites column 5, lines 57-64 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse and assert that Tachibana instead discloses an operating system receiving information that a PC card is removed from a PC card slot. There is no language in the cited passage that discloses unloading a driver for an expansion device. Neither is there any language in the cited passage that discloses unloading a driver for an expansion device connected to an interface to allow the expansion device to be removed. Thus, Tachibana does not disclose all of the limitations of claim 4, and thus Tachibana does not anticipate claim 4. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 5, lines 57-64) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 9. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 5, lines 57-64 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must

make clear that column 5, lines 57-64 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 4. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "said listing section and said specification acceptance section together comprising the plurality of interfaces which allow the expansion devices to be attached and detached" as recited in claim 4. The Examiner cites column 2, line 65 – column 3, line 19 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse and assert that Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses that a listing section (displaying a list which indicates whether to permit removal of an expansion device) and a specification acceptance section (accepting specification of a specific interface contained in the list) together comprising a plurality of interfaces. Neither is there any language in the cited passage that discloses that a listing section and a specification acceptance section together comprising a plurality of interfaces which allow the expansion devices to be attached and detached. Thus, Tachibana does not disclose all of the limitations of claim 4, and thus Tachibana does not anticipate claim 4. M.P.E.P. §2131.

C. Claim 8 is not anticipated by Tachibana.

Appellants further assert that Tachibana does not disclose "displaying an explicit list of removable expansion devices in response to a certain operation, based on an information list which indicates whether the expansion devices are removable from a computer system" as recited in claim 8. The Examiner cites column 6, lines

11-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that requests the operating system to issue card/program registration information held in the registry; acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information; and then requests the operating system to start the application program. There is no language in the cited passage that discloses displaying a list of removable expansion devices. Neither is there any language in the cited passage that discloses displaying a list of removable expansion devices in response to a certain operation. Neither is there any language in the cited passage that discloses displaying a list of removable expansion devices in response to a certain operation, based on an information list which indicates whether the expansion devices are removable from a computer system. Thus, Tachibana does not disclose all of the limitations of claim 8, and thus Tachibana does not anticipate claim 8. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "accepting specification of a specific expansion device from among the expansion devices listed explicitly" as recited in claim 8. The Examiner cites column 6, lines 11-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that requests the operating system to issue card/program registration information held in the registry; acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information; and then requests the operating system to start the application program. There is no language in the cited passage that discloses accepting specification of a specific expansion device from among the expansion devices listed. Thus, Tachibana does not disclose all of the limitations of claim 8, and thus Tachibana does not anticipate claim 8. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "unloading said specified specific expansion device from a system of said computer device" as recited in claim 8. The Examiner recites column 6, lines 38-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that requests the operating system to terminate the application which is now executed. There is no language in the cited passage that discloses unloading an expansion device from a system of a computer device. Thus, Tachibana does not disclose all of the limitations of claim 8, and thus Tachibana does not anticipate claim 8. M.P.E.P. §2131.

D. Claim 12 is not anticipated by Tachibana.

Appellants further assert that Tachibana does not disclose "detecting expansion devices connected to the computer device" as recited in claim 12. The Examiner cites column 6, lines 11-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 6. Appellants respectfully traverse. As stated above, Tachibana instead discloses a utility program that requests the operating system to issue card/program registration information held in the registry; acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information; and then requests the operating system to start the application program. There is no language in the cited passage that discloses detecting expansion devices connected to a computer device. Thus, Tachibana does not disclose all of the limitations of claim 12, and thus Tachibana does not anticipate claim 12. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 6, lines 11-45) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 10. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation.

The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 6, lines 11-45 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 6, lines 11-45 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 12. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "accepting specification as to whether or not removal of said detected expansion devices from the computer device is prohibited" as recited in claim 12. The Examiner cites column 2, line 65 – column 3, line 19 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 7. Appellants respectfully traverse. As stated above, Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses accepting specification as to whether or not removal of a detected expansion device from a computer device is prohibited. Thus, Tachibana does not disclose all of the limitations of claim 12, and thus Tachibana does not anticipate claim 12. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "displaying a list of expansion devices, excluding the expansion devices which are prohibited from being removed, when requested to display a list of the expansion devices connected to the computer device" as recited in claim 12. The Examiner cites column 6, lines 11-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 7. Appellants respectfully traverse. As stated above, Tachibana instead discloses a

utility program that requests the operating system to issue card/program registration information held in the registry; acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information; and then requests the operating system to start the application program. There is no language in the cited passage that discloses displaying a list of expansion devices. Neither is there any language in the cited passage that discloses displaying a list of expansion devices excluding the expansion devices which are prohibited from being removed. Neither is there any language in the cited passage that discloses displaying a list of expansion devices, excluding the expansion devices which are prohibited from being removed, when requested to display a list of the expansion devices connected to the computer device. Thus, Tachibana does not disclose all of the limitations of claim 12, and thus Tachibana does not anticipate claim 12. M.P.E.P. §2131.

E. Claims 2-3, 5-7, 9-11 and 13-15 are not anticipated by Tachibana for at least the reasons mentioned above in Sections A-D.

Claims 2-3 depend from claim 1 and hence are not anticipated by Tachibana for at least the reasons that claim 1 is not anticipated by Tachibana as discussed above in Section A. Claims 5-7 depend from claim 4 and hence are not anticipated by Tachibana for at least the reasons that claim 4 is not anticipated by Tachibana as discussed above in Section B. Claims 9-11 depend from claim 8 and hence are not anticipated by Tachibana for at least the reasons that claim 8 is not anticipated by Tachibana as discussed above in Section C. Claims 13-15 depend from claim 12 and hence are not anticipated by Tachibana for at least the reasons that claim 12 is not anticipated by Tachibana as discussed above in Section D.

F. Claim 2 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "a setting change unit for changing said setting information stored in said information storage

unit, based on outside requests" as recited in claim 2. The Examiner cites column 5, line 47 – column 6, line 37 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 3. Appellants respectfully traverse and assert that Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses settings information which indicates whether the expansion devices connected to an interface are removable. Neither is there any language in the cited passage that discloses a unit for changing such settings information. Neither is there any language in the cited passage that discloses a unit for changing such settings information based on outside requests. Thus, Tachibana does not disclose all of the limitations of claim 2, and thus Tachibana does not anticipate claim 2. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 5, line 47 – column 6, line 37) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 10. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 5, line 47 – column 6, line 37 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 5, line 47 – column 6, line 37 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 2. M.P.E.P. §2131.

G. Claims 3 and 14 are not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "wherein said information storage unit is a non-volatile memory which stores information referenced by BIOS (basis input/output system)" as recited in claim 3. Appellants further assert that Tachibana does not disclose "wherein said process of accepting specification stores information about said specification in a non-volatile memory which stores data referenced by a BIOS of the computer device" as recited in claim 14. The Examiner cites column 5, line 47 – column 6, line 37 of Tachibana as disclosing the above-cited claim limitations. Paper No. 5, page 3. Appellants respectfully traverse. As stated above, Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses a non-volatile memory storing information referenced by the BIOS. Neither is there any language in the cited passage that discloses storing information about a specification in a non-volatile memory. Neither is there any language in the cited passage that discloses storing information about a specification in a non-volatile memory which stores data referenced by a BIOS of the computer device. Thus, Tachibana does not disclose all of the limitations of claims 3 and 14, and thus Tachibana does not anticipate claims 3 and 14. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 5, line 47 – column 6, line 37) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 10. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 5, line 47 – column 6, line 37 of Tachibana that it discloses the above-cited claim limitation. *See*

Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 5, line 47 – column 6, line 37 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claims 3 and 14. M.P.E.P. §2131.

H. Claim 5 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "wherein said listing section lists only the interfaces from which removal of expansion devices is permitted" as recited in claim 5. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse and assert that Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses listing only the interfaces from which removal of expansion devices is permitted. Thus, Tachibana does not disclose all of the limitations of claim 5, and thus Tachibana does not anticipate claim 5. M.P.E.P. §2131.

I. Claim 6 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "wherein said specification acceptance section accepts only the specification of the interfaces from which removal of expansion devices is permitted" as recited in claim 6. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse. As stated above, Tachibana instead discloses acquiring information indicating data of

insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses accepting only the specification of the interfaces from which removal of expansion devices is permitted. Thus, Tachibana does not disclose all of the limitations of claim 6, and thus Tachibana does not anticipate claim 6. M.P.E.P. §2131.

J. Claim 7 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "a choice acceptance section for accepting choices as to whether or not removal of the expansion device from each of the plurality of interfaces should be permitted" as recited in claim 7. The Examiner cites column 6, lines 11-45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 4. Appellants respectfully traverse and assert that Tachibana instead discloses a utility program that requests the operating system to issue card/program registration information held in the registry; acquires information of an application program corresponding to the inserted PC card by referring to the card/program registration information; and then requests the operating system to start the application program. There is no language in the cited passage that discloses accepting choices as to whether or not removal of the expansion device from each of the plurality of interfaces should be permitted. Thus, Tachibana does not disclose all of the limitations of claim 7, and thus Tachibana does not anticipate claim 7. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 6, lines 11-45) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 11. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the

Examiner's interpretation of column 6, lines 11-45 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 6, lines 11-45 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 7. M.P.E.P. §2131.

K. Claim 9 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "an OS (Operating System) of said computer devices makes an inquiry to a BIOS" as recited in claim 9. The Examiner cites column 5, line 47 – column 6, line 37 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse. As stated above, Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses an operating system that makes an inquiry to a BIOS. Thus, Tachibana does not disclose all of the limitations of claim 9, and thus Tachibana does not anticipate claim 9. M.P.E.P. §2131.

In response to Appellants' previous argument, the Examiner essentially asserts that he interprets the cited passage (column 5, line 47 – column 6, line 37) in Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 11. However, the Examiner has not provided any basis in fact and/or technical reasoning to support the assertion that the cited passage in Tachibana does indeed disclose the above-cited claim limitation. The Examiner must provide a basis in fact and/or technical reasoning to support the Examiner's interpretation of column 5, line 47 – column 6, line 37 of Tachibana that it discloses the above-cited claim limitation. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the

Examiner must provide extrinsic evidence that must make clear that column 5, line 47 – column 6, line 37 of Tachibana discloses the above-cited claim limitation, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of anticipation in rejecting claim 9. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "the BIOS replies as to whether or not each of the expansion devices is removable, with reference to the information list" as recited in claim 9. The Examiner cites column 5, line 47 – column 6, line 45 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse. As stated above, Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses a BIOS replying as to whether or not each of the expansion devices is removable. Neither is there any language in the cited passage that discloses a BIOS replying as to whether or not each of the expansion devices is removable, with reference to an information list which indicates whether the expansion devices are removable. Thus, Tachibana does not disclose all of the limitations of claim 9, and thus Tachibana does not anticipate claim 9. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "the OS indicates a list of removable expansion devices explicitly based on a reply from the BIOS" as recited in claim 9. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse. As stated above, Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses an operating

system indicating a list of removable expansion devices. Neither is there any language in the cited passage that discloses an operating system indicating a list of removable expansion devices explicitly based on a reply from the BIOS. Thus, Tachibana does not disclose all of the limitations of claim 9, and thus Tachibana does not anticipate claim 9. M.P.E.P. §2131

L. Claim 10 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "receiving, from outside, settings concerning whether the expansion devices are removable from said computer device and generating settings information based on the received settings" as recited in claim 10. The Examiner cites column 5, line 47 – column 6, line 3 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 6. Appellants respectfully traverse and assert that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. Receiving information as to whether a PC card is inserted or removed is not the same as receiving settings concerning whether the expansion devices are removable from a computer device. Neither is there any language in the cited passage that discloses generating information based on the received settings where the settings concern whether the expansion devices are removable from a computer device. Thus, Tachibana does not disclose all of the limitations of claim 10, and thus Tachibana does not anticipate claim 10. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "generating the information list with reference to said settings information during system startup of said computer device" as recited in claim 10. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 6. Appellants respectfully traverse. As stated above, Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device

information held in the registry. There is no language in the cited passage that discloses generating an information list with reference to the settings information (generated based on the received settings concerning whether the expansion devices are removable) during system startup of a computer device. Thus, Tachibana does not disclose all of the limitations of claim 10, and thus Tachibana does not anticipate claim 10. M.P.E.P. §2131.

M. Claim 11 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "wherein when the settings concerning whether or not the expansion devices are removable from said computer device are received from the outside, said step of generating settings information stores the settings information generated based on the received settings in a non-volatile memory which stores data referenced by a BIOS of said computer device" as recited in claim 11. The Examiner has not cited to any passage in Tachibana as disclosing the above-cited claim limitation. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §2131. The Examiner has not provided any evidence that Tachibana either expressly or inherently describes the above-cited claim limitation. Consequently, the Examiner has not provided a *prima facie* case of anticipation in rejection claim 11. M.P.E.P. §2131.

N. Claim 13 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "wherein said process of accepting specification is executed if a certain operation is performed during system startup of the computer device" as recited in claim 13. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim

limitation. Paper No. 5, page 7. Appellants respectfully traverse. Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses that the process of accepting specification is executed if a certain operation is performed during system startup of the computer device. Thus, Tachibana does not disclose all of the limitations of claim 13, and thus Tachibana does not anticipate claim 13. M.P.E.P. §2131.

O. Claim 15 is not anticipated by Tachibana.

Appellants respectfully assert that Tachibana does not disclose "a process in which an OS of the computer device asks the BIOS for information needed to display said list" as recited in claim 15. The Examiner cites column 5, line 47 – column 6, line 37 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 5. Appellants respectfully traverse. As stated above, Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses an operating system asking a BIOS for information needed to display a list (a list of expansion devices). Thus, Tachibana does not disclose all of the limitations of claim 15, and thus Tachibana does not anticipate claim 15. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "a process in which the BIOS provides information as to whether each of the expansion devices is removable, with reference to the information about said specification stored in said non-volatile memory" as recited in claim 15. The Examiner cites column 5, line 47 – column 6, line 45. Paper No. 5, page 5. Appellants respectfully traverse. As stated above, Tachibana instead discloses that the operating system receives information as to when a PC card is inserted or removed from a PC card slot. There is no language in the cited passage that discloses a BIOS providing information as to whether each of

the expansion devices is removable. Neither is there any language in the cited passage that discloses a BIOS providing information as to whether each of the expansion devices is removable, with reference to the information about a specification stored in a non-volatile memory. Thus, Tachibana does not disclose all of the limitations of claim 15, and thus Tachibana does not anticipate claim 15. M.P.E.P. §2131.

Appellants further assert that Tachibana does not disclose "a process in which the OS displays a list of removable expansion devices based on the information provided by the BIOS" as recited in claim 15. The Examiner cites column 3, lines 20-39 of Tachibana as disclosing the above-cited claim limitation. Paper No. 5, page 6. Appellants respectfully traverse. As stated above, Tachibana instead discloses acquiring information indicating data of insertion/removal and a name of an expansion card inserted into or removed from the card slot by referring to device information held in the registry. There is no language in the cited passage that discloses displaying a list of removable expansion devices. Neither is there any language in the cited passage that discloses displaying a list of removable expansion devices based on information provided by a BIOS. Thus, Tachibana does not disclose all of the limitations of claim 15, and thus Tachibana does not anticipate claim 15. M.P.E.P. §2131.

VIII. CONCLUSION

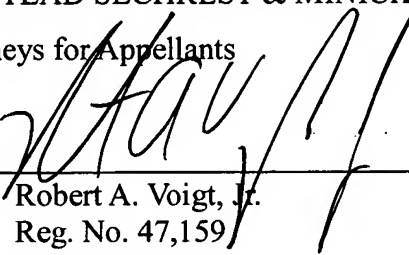
For the reasons noted above, the rejections of claims 1-15 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-15.

Respectfully submitted,

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APPENDIX

1. Apparatus comprising:
 - an interface which provides removable connection to a plurality of expansion devices;
 - an information storage unit for storing settings information which indicates whether the expansion devices connected to said interface are removable; and
 - a listing unit for listing the expansion devices removable from said interface, based on said settings information stored in said information storage unit;
 - said information storage unit and said listing unit together comprising an interface which allows expansion devices to be attached and detached.
2. The apparatus according to claim 1, further comprising a setting change unit for changing said settings information stored in said information storage unit, based on outside requests.
3. The apparatus according to claim 1, wherein said information storage unit is a non-volatile memory which stores information referenced by BIOS (basic input/output system).
4. Apparatus comprising:
 - an interface section having a plurality of interfaces, each interface providing removable connection to a plurality of expansion devices;
 - a listing section for displaying a list based on settings information which indicates whether to permit removal of an expansion device from each of said interfaces;
 - a specification acceptance section for accepting specification of a specific interface from among said interfaces contained in said list; and
 - an unloading section for unloading a driver for the expansion device

connected to said specific interface to allow the expansion device to be removed;

said listing section and said specification acceptance section together comprising the plurality of interfaces which allow the expansion devices to be attached and detached.

5. The apparatus according to claim 4, wherein said listing section lists only the interfaces from which removal of expansion devices is permitted.

6. The apparatus according to claim 4, wherein said specification acceptance section accepts only the specification of the interfaces from which removal of expansion devices is permitted.

7. The apparatus according to claim 4, further comprising a choice acceptance section for accepting choices as to whether or not removal of the expansion device from each of the plurality of interfaces should be permitted.

8. A method comprising the steps of:

displaying an explicit list of removable expansion devices in response to a certain operation, based on an information list which indicates whether the expansion devices are removable from a computer device;

accepting specification of a specific expansion device from among the expansion devices listed explicitly; and

unloading said specified specific expansion device from a system of said computer device.

9. The method according to claim 8, wherein said step of displaying said explicit list comprises steps in which:

an OS (Operating System) of said computer device makes an inquiry to a BIOS;

the BIOS replies as to whether or not each of the expansion devices is removable, with reference to the information list; and

the OS indicates a list of removable expansion devices explicitly based on a reply from the BIOS.

10. The method according to claim 8, further comprising the steps of:

receiving, from outside, settings concerning whether the expansion devices are removable from said computer device and generating settings information based on the received settings; and

generating the information list with reference to said settings information during system startup of said computer device.

11. The method according to claim 10, wherein when the settings concerning whether or not the expansion devices are removable from said computer device are received from the outside, said step of generating settings information stores the settings information generated based on the received settings in a non-volatile memory which stores data referenced by a BIOS of said computer device.

12. A program product comprising:

a computer readable medium;

a computer executable program stored on said computer readable medium for execution on a computer device, said computer executable program being effective in executing the steps of:

detecting expansion devices connected to the computer device;

accepting specification as to whether or not removal of said detected expansion devices from the computer device is prohibited; and

displaying a list of expansion devices, excluding the expansion devices which are prohibited from being removed, when requested to display a list of the expansion devices connected to the computer device.

13. The program product according to claim 12, wherein said process of accepting specification is executed if a certain operation is performed during system startup of the computer device.

14. The program product according to claim 13, wherein said process of accepting specification stores information about said specification in a non-volatile memory which stores data referenced by a BIOS of the computer device.

15. The program product according to claim 14, wherein said process of displaying a list comprises:

- a process in which an OS of the computer device asks the BIOS for information needed to display said list;

- a process in which the BIOS provides information as to whether each of the expansion devices is removable, with reference to the information about said specification stored in said non-volatile memory; and

- a process in which the OS displays a list of removable expansion devices based on the information provided by the BIOS.